

REMARKS

Claims 3, 4, and 6-9 are pending in this application after this Amendment. Claims 1, 2, and 5 have been canceled without prejudice or disclaimer. Claims 6-9 have been added. In light of the amendments and remarks made herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claims 1-3 and 5 under 35 U.S.C. § 103(a) as being unpatentable over *Malkin et al.* (USP 6,614,474) in view of *Safai* (USP 6,593,963) and further in view of *Nagashima* (USP 4,791,308); and rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Malkin et al.*, *Safai*, and *Nagashima*, and further in view of *Sasaki et al.* (USP 5,034,804). Applicant respectfully traverses these rejections.

The Examiner additionally rejected claim 5 under 35 U.S.C. § 112, second paragraph.

**Claim Rejections - 35 U.S.C. § 112**

With regard to the Examiner's rejection of claim 5, by this Amendment, Applicant has canceled claim 5 without prejudice or disclaimer to the subject matter contained therein. Based upon this cancellation, it is respectfully requested that the outstanding rejection be withdrawn.

## Claim Rejections - 35 U.S.C. § 103

By this Amendment, Applicant has canceled claims 1 and 2 and has added new claims 6-9 for consideration by the Examiner. It is respectfully submitted that new independent claims 6 and 7 are patentable over the references as cited by the Examiner.

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The present invention as set forth in claim 6 recites, *inter alia*, a digital still camera comprising a downsampling device for downsampling the video signal outputted from the imaging device using a first downsampling-ratio; and an electronic zoom device for processing an electronic zoom wherein the image included in the zoom area designated by the zoom area designating device is displayed entirely on the display screen of the display device using a zoom ratio, comprising a controller for controlling the

downsampling device so as to carry out the downsampling processing using a second downsampling ratio, which ratio of downsampling is smaller than the first downsampling ratio, when the zoom ratio at the electronic device is higher than a zoom ratio which enlarges the original image to the image after downsampling using the first downsampling ratio.

In the outstanding Official Action, the Examiner admits that neither *Malkin et al.* nor *Safai* teach or suggest that the downsampling ratio may be reduced in response to the application of the electronic zoom command. The Examiner relies on the teachings of *Nagashima* to cure the deficiencies of the teachings of *Malkin et al.* and *Safai*. Applicant respectfully disagrees with the Examiner's characterization of the references.

It is respectfully submitted that the disclosure of *Nagashima* is directed to a solid-state image pick-up apparatus having variable magnification of image sizes by changing the image sensor address range. Specifically, *Nagashima* teaches at col. 4, lines 36-44 as follows:

...In one mode, the image pick-up magnification is set at one and, in the other, the magnification is set at 1/2.

(i) One magnification mode: In this mode, out of a total of 1000.times.1000 picture elements of the sensor S, data for 500.times.500 picture elements corresponding to the hatched part of FIG. 2 located at addresses 251 to 750 in the horizontal direction and addresses 251 to 750 in the vertical direction is read out in an interlacing manner.

As shown above, *Nagashima* teaches utilizing half of the picture elements of the sensor in response to the magnification being set at  $\frac{1}{2}$ . However, *Nagashima* fails to teach or suggest a controller for controlling the downsampling device so as to carry out the downsampling processing using a second downsampling ratio, which ratio of downsampling is smaller than the first downsampling ratio, when the zoom ratio at the electronic zoom device is higher than a zoom ratio which enlarges the image to the image after downsampling using the first downsampling ratio. Thus, as *Nagashima* fails to cure the deficiencies of the teachings of *Malkin et al.* and *Safai*, assuming these references are combinable, which Applicant does not admit, it is respectfully submitted that claim 6 is not obvious over the references as cited by the Examiner.

Additionally, one of ordinary skill in the art would not be motivated to combine the teachings of *Nagashima* with the teachings of *Malkin et al.* As noted above, *Nagashima* teaches utilizing half of the picture elements of the sensor in response to the magnification being set at  $\frac{1}{2}$ . However, *Malkin et al.* discloses an electronic tilt zoom video camera where the image having 640 pixels horizontally and 480 pixels vertically is transformed to an image having 352 pixels horizontally and 288 pixels vertically. Thus, it would be impossible to utilize the teachings of *Nagashima* by utilizing half of the picture elements of the sensor after the

image of Malkin et al. is acquired and downsampled. The opportunity to downsample at the sensor has passed. As such, there is no motivation to combine the teachings of the references as asserted by the Examiner. As there is no motivation to combine the teachings of the references, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. §103. It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 3 and 4 are allowable for the reasons set forth above with regard to claim 6 at least based upon their dependency on claim 6.

It is further respectfully submitted that claim 7 contains element similar to those discussed above with regard to claim 6 and, thus, claim 7, together with claims dependent thereon, are allowable over the references as cited.

#### Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicant respectfully petitions for a one (1) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the


amount of \$110.00 in payment of the extension of time fee is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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